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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/556,224

09/27/2006

Martin Hendrix

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10/29/2008

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EXAMINER

MOORE, SUSANNA

ART UNIT

PAPER NUMBER

1624

MAIL DATE

DELIVERY MODE

10/20/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/556,224

Applicant(s)

HENDRIX ET AL

Examiner

SUSANNA MOORE

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9, 13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) 7, 13 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-824)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 7/21/08, 9/27/06, 11/9/05

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Group I in the reply filed on 7/21/2008 is acknowledged. Group I, drawn to pyrazolo[3,4-d]pyrimidines and simple compositions, embraced by claims 1-6 and 9 was elected by Applicant. Applicant has not pointed to any errors in the Examiners analysis of the classification of the different inventions. The requirement is still deemed proper and is therefore made **FINAL**.

There are 8 claims pending and 5 under consideration. Claims 1-6 are compound claims. Claim 9 is a composition claim. Claims 7, 13 and 14 are drawn to nonelected subject matter. This is the first action on the merits. The application concerns some pyrazolo[3,4-d]pyrimidine compounds and simple compositions thereof.

Specification

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: 6-Cyclylmethyl and 6-Alkylmethyl Pyrazolo[3,4-d]pyrimidines.

The disclosure is objected to because of the following informalities:

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase

“Not Applicable” should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).**
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A “Sequence Listing” is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required “Sequence Listing” is not submitted as an electronic document on compact disc).

The abstract of the disclosure is objected to because the abstract is too vague. The abstract should provide a short summary of the invention. The Examiner suggests using claim 1 with the structure for the abstract. Correction is required. See MPEP § 608.01(b).

Information Disclosure Statement

The information disclosure statements (IDSs) submitted on 7/21/2008, 9/27/06 and 11/9/2005 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Objections

This application contains claims 7, 13 and 14, drawn to an invention nonelected without

traverse in the paper of 7/21/2008. A complete reply to the Final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144). See MPEP § 821.01.

Claims 2-6 and 9 are objected to because of the following informalities: the term “Claim” should not be capitalized. Appropriate correction is required.

Claims 5 and 6 are objected to because of the following informalities: the preamble states, “A compound Claim 1,” which is not grammatically correct. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-6 and 9 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a conjugate of claim 1 or pharmaceutically acceptable salts of said conjugate does not reasonably provide enablement for a solvate of a conjugate of claim 1. The specification does not provide sufficient guidance nor does it enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

As stated in the MPEP 2164.01 (a), "There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue."

In *In re Wands*, 8 USPQ2d 1400 (1988), factors to be considered in determining whether a disclosure meets the enablement requirement of 35 U.S.C. 112, first paragraph, have need described. They are:

1. the nature of the invention,
2. the state of the prior art,
3. the predictability or lack thereof in the art,
4. the amount of direction or guidance present,
5. the presence or absence of working examples,
6. the breadth of the claims,
7. the quantity of experimentation needed, and
8. the level of the skill in the art.

In the instant case:

The nature of the invention

The nature of the invention is a compound of the formula in claim 1, or a pharmaceutically acceptable salt of said compound. The only teaching of solvates of the compounds of formula of claim 1 in the specification is the definition of the term solvates, generally, on page 5.

The state of the prior art and predictability or lack thereof in the art

It is the state of the prior art that the term "solvate" found in the claims is defined as a compound formed by solvation (the combination of solvent molecules with molecules or ions of the solute. It has been estimated that approximately one-third of the pharmaceutically active substances are capable of forming crystalline hydrates. Predicting the formation of solvates or hydrates of a compound and the number of molecules of water or solvent incorporated into the crystal lattice of a compound is complex and difficult. Each solid compound responds uniquely to the possible formation of solvates and hence generalizations cannot be made for a series of related compound (See Vippagunta, et al.)

The scope of "solvate" is not adequately enabled or defined. Applicants provide no guidance as how the compounds are made more active in vivo. Solvates and hydrates cannot always be predicted and therefore are not capable of being claimed if the applicant cannot properly enable a particular solvate.

The amount of direction or guidance present and the presence or absence of working examples

There is no direction or guidance present in the specification or working examples present in the specification are that defines or relates to what solvates are being included in the elected invention.

The breadth of the claims

The breadth of the claims is a compound of formula (I) of claim 1 or a pharmaceutically acceptable salt or solvate thereof.

The quantity of experimentation needed and the level of the skill in the art

While the level of the skill in the pharmaceutical art is high, the quantity of experimentation needed is undue experimentation. One of skill in the art would need to prepare compounds with various solvents without any direction as to what compounds form solvates with which solvents.

The level of skill in the art is high without showing or guidance as to how to make solvates of a conjugate of claim 1 it would require undue experimentation to figure out the solvents, temperatures and reaction times that would provide solvates of the above compounds.

To overcome this objection, Applicant should submit an amendment deleting the term "solvates."

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6 and 9 are rejected under 35 U.S.C. 102(c) as being anticipated by Linker et. al. (DE 10219435).

The reference teaches compounds of formula (I), wherein R^1 = ethyl and R^2 = 2,4-dichlorophenyl. See the top of page 19. This is just one example, there maybe more.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(c). This rejection under 35 U.S.C. 102(c) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cheng et. al. (J. Org. Chem, 1958, (23) 191-200).

The instant Application claims compounds of formula (I), wherein R¹= ethyl and R²= 4-methylphenyl.

The reference teaches compounds of formula (I), wherein R¹= ethyl and R²= phenyl. See page 195, table II, the 17th specie listed from top to bottom. Also note, the compounds were recrystallized in ethanol and water, pharmaceutically acceptable carriers.

The only difference between the instant Application and the reference is the substituent at R², a phenyl versus Applicant's 4-methylphenyl. The reference teaches guideposts with 4-

methylphenyl, see the 19th specie listed in table II. Furthermore, since a methyl group is considered a homolog of hydrogen these compounds are considered equivalent. The MPEP 2144.09 states “Compounds which are... homologs (compounds differing regularly by the successive addition of the same chemical group, e.g., by -CH₂- groups) are generally of sufficiently close structural similarity that there is a presumed expectation that such compounds possess similar properties. *In re Wilder*, 563 F.2d 457, 195 USPQ 426 (CCPA 1977). Also, note *In re Magerlein*, 202 USPQ 473; *In re Wood*, 199 USPQ 137; *In re Hoke*, 195 USPQ 148; *In re Lohr*, 137 USPQ 548.

Additionally, the instant Application claims compounds of formula (I), wherein R¹= ethyl and R²= 4-methylphenyl.

The reference teaches compounds of formula (I), wherein R¹= methyl and R²= 4-methylphenyl. See page 195, table II, the 19th specie listed from top to bottom. Also note, the compounds were recrystallized in ethanol and water, pharmaceutically acceptable carriers.

The only difference between the instant Application and the reference is the substituent at R¹, a methyl versus Applicant's ethyl. The reference teaches guideposts with ethyl, see the 17th specie listed in table II. Furthermore, the MPEP 2144.09 states “Compounds which are position isomers (compounds having the same radicals in physically different positions on the same nucleus) ... are generally of sufficiently close structural similarity that there is a presumed expectation that such compounds possess similar properties. *In re Wilder*, 563 F.2d 457, 195 USPQ 426 (CCPA 1977).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUSANNA MOORE whose telephone number is (571)272-9046. The examiner can normally be reached on M-F 8:00-5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Wilson can be reached on (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Susanna Moore/
Examiner, Art Unit 1624

/James O. Wilson/
Supervisory Patent Examiner, Art Unit 1624